

Application No. 10/658,910
Response Dated April 5, 2006
Reply to Office Action of January 5, 2006

REMARKS/ARGUMENTS

1. Remarks on the Amendment

Claims 1, 7 and 12 have been amended to more specifically define Applicant's claimed invention.

Antecedent basis for the amendment can be found in the Specification as filed. More specifically, antecedent basis for the amendment of Claims 1 and 7 can be found in Claim 7 and on page 8, lines 13-14 of the Specification.

Applicant respectfully submits no new matter has been introduced by the amendments.

2. Response to the Rejection of Claims 1 and 3-6 Based Upon 35 U.S.C. §102(b)

Claims 1 and 3-6 stand rejected under 35 USC §102(b) as being anticipated by Walthers (U.S. Patent No. 6,010,034). This rejection is respectfully traversed.

Claim 1 is an independent claim. Claims 3-6 are dependent claims of Claim 2, which depends on Claim 1.

For there to be anticipation under 35 U.S.C. §102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros vs. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1581, 230 USPQ 81, 84 (Fed. Cir. 1986) ("Absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject

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matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

As positively recited in Claim 1, Applicant's claimed bottle cap including a telescope straw located adjacent to the outlet opening, said telescope straw having a first straw portion and a second straw portion, the first straw portion being secured to the cap body, and the second straw portion being axially movable and extending upwardly out of the nozzle.

Applicant submits that the claimed subject matter is not disclosed, taught or suggested by the art of record. More specifically, Walthers fails to teach Applicant's claimed bottle cap which comprising a telescope straw that has a first straw portion and a second straw portion, and the second straw portion being axially movable and extending upwardly out of the nozzle.

As the Examiner has stated in the Section 6 of the Office Action, Walthers reference lacks a telescope straw with a first straw portion and a second straw portion; with the second straw portion being axially movable and extending upwardly out of the nozzle (page 5, the last paragraph of the Office Action).

Applicant respectfully points out that the rejection under 35 U.S.C. §102(b) is improper, because the prior art reference fails to teach "each and every element" of the claimed invention.

Therefore, Applicant maintains that that Applicant's invention defined by Claim 1 is not anticipated by Walthers.

With regard to Claims 3-6 as described above, these claims are dependent upon independent Claim 1. Under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 1 is not anticipated by the prior art of record, as such Claims 3-6 are submitted as being allowable over the art of record.

Furthermore, Applicant points out that Claims 3-6 depend on Claim 2, not

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directly depend on Claim 1. Since Claim 2 is only rejected under 35 U.S.C. §103(a), not under §102(b), the rejection of Claims 3-6 under §102(b) is improper.

In view of the above, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 3-6 based upon 35 U.S.C. §102(b).

3. Response to the Rejection of Claims 7-10 Based Upon 35 U.S.C. §102(b)

Claims 7-10 stand rejected under 35 USC §102(b) as being anticipated by Lau (U.S. Patent No. 5,799,873). This rejection is respectfully traversed.

Claim 7 is an independent claim. Claims 8-10 are dependent claims of Claim 7.

The applicable case law for a rejection under 35 U.S.C. §102(b) has been discussed above. In the interests of brevity, Applicants request the Examiner to note the above sections and consider that material incorporated herein by reference.

As positively recited in the amended Claim 7, Applicant's claimed multifunctional bottle cap includes an upwardly protruding nozzle with an outlet opening at an edge portion of the protruding nozzle for dispensing liquid by tilting the bottle; and a straw having an upper end extending out of the protruding nozzle adjacent to the outlet opening, the straw being vertically movable to extend upwardly from the cap body.

Lau fails to teach or imply Applicant's claimed cap having an upwardly protruding nozzle with an outlet opening at an edge portion of the protruding nozzle for dispensing liquid by tilting the bottle. Lau further fails to teach Applicant's claimed bottle cap including a straw that has an upper end extending out of the protruding nozzle adjacent to the outlet opening, and the straw being vertically movable to extend upwardly from the cap body.

It is apparent that Lau fails to teach the structural feature of Applicant's claimed straw, which is a key component of Applicant's claimed multifunctional bottle cap.

Therefore, Applicant maintains that that Applicant's invention defined by Claim

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7 is not anticipated by Lau.

With regard to Claims 8-10 as described above, these claims are dependent upon independent Claim 7. Under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 7 is not anticipated by the prior art of record, as such Claims 8-10 are submitted as being allowable over the art of record.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 7-10 based upon 35 U.S.C. §102(b).

4. Response to the Rejection of Claims 1 and 2 Based Upon 35 U.S.C. §103(a)

Claims 1 and 2 stand rejected under 35 USC §103(a) as being unpatentable over Walthers (U.S. Patent No. 6,010,034) in view of Pugh (US Patent No. 2,805,809). This rejection is respectfully traversed.

A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and prior art; and (4) the objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), see also *Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching or motivation to combine the

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prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175, F.3d 994, 1000, 50 USPQ 2d 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The examiner has the burden of establishing a prima facie case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of the establishing prima facie case is met does the burden of coming forward with rebuttal argument or evidence shift to the application. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Applicant submits that nothing in the art of record teaches or suggests the subject matter positively recited in the amended Independent Claim 1.

Walthers' teaching has been discussed above in view of the rejection under 35 U.S.C. §102(b).

Walthers further fails to teach following structural components of Applicant's claimed bottle cap:

(a) an outlet opening at an edge portion of the nozzle for dispensing liquid therefrom by titling the bottle;

(b) a closing lid that is movable to close and open the outlet opening; and

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(c) a telescope straw located adjacent to the outlet opening for drinking through the straw, said telescope straw having a first straw portion and a second straw portion, the first straw portion being secured to the cap body, and the second straw portion being axially movable and extending upwardly out of the nozzle.

Applicant respectfully points out that the outlet opening and the straw in Applicant's claimed bottle cap are two independent structural components and serve the user two different functions. The outlet opening is for dispersing liquid from the bottle by tilting the bottle, and the straw is for drinking through it.

On the contrary, Walthers' bottle does not have the outlet opening for dispensing the liquid by tilting the bottle (see the exploded view in Fig. 3 of the reference). Walthers' bottle only serves for drinking through the straw and spraying.

Therefore, Walthers fails to teach Applicant's claimed invention defined by Claim 1.

The deficiencies of Walthers are not overcome by Pugh.

Pugh teaches a container with a telescopic straw having inner and outer sections. Pugh fails to teach Applicant's claimed outlet opening for dispersing liquid from the bottle by tilting the bottle.

Since neither reference teaches Applicant's claimed outlet opening on an upwardly protruding nozzle for dispersing liquid from the bottle by tilting the bottle, one of ordinary skill in the art would not be motivated, in the manner suggested by the Examiner, to combine the references' teachings to obtain Applicant's claimed invention. Even if one combines, one would not obtain Applicant's claimed invention.

Therefore, Applicant maintains that Applicant's claimed invention defined by independent Claim 1 is not obvious.

Since Claim 2 is dependent upon independent Claim 1, under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 1 is not obvious in view of the prior art of record, as such Claim 2 is submitted as being allowable over the art of record.

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Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1 and 2 based upon 35 U.S.C. §103(a).

5. Response to the Rejection of Claims 7 and 11-12 Based Upon 35 U.S.C. §103(a)

Claims 7 and 11-12 stand rejected under 35 USC §103(a) as being unpatentable over Lau (U.S. Patent No. 5,799,873) in view of Pugh (US Patent No. 2,805,809). This rejection is respectfully traversed.

Claim 7 is an independent claim. Claims 11-12 are dependent claims of Claim 7.

The applicable case law for a rejection under 35 U.S.C. §103(a) has been discussed above. In the interests of brevity, Applicants request the Examiner to note the above sections and consider that material incorporated herein by reference.

Applicant submits that nothing in the art of record teaches or suggests the subject matter positively recited in the amended independent Claim 7.

Lau's teaching has been discussed above. As stated above, Lau fails to teach the following structures of Applicant's claimed multifunctional bottle cap defined by Claim 7:

(a) an upwardly protruding nozzle with an outlet opening at an edge portion of the protruding nozzle, the outlet opening enabling dispensing liquid therefrom by tilting the bottle;

(b) a straw that has an upper end extending out of the protruding nozzle adjacent to the outlet opening, and the straw being vertically movable to extend upwardly from the cap body; and

(c) a spray assembly next to the protruding nozzle, the assembly having a pump button extending upwardly.

It is important to understand that in Applicant's claimed multifunctional bottle cap the protruding nozzle, the straw and the spray assembly are three independent structural components and serves the user three different functions: (1) dispensing

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liquid through the outlet opening by tilting the bottle; (2) drinking through the straw; and (3) spraying by the spray assembly.

Lau's dispensing system can do only two of the three, i.e., drinking from the straw and spray by the trigger sprayer, because Lau's dispensing system does not have the outlet opening for dispensing liquid by tilting the bottle.

Applicant respectfully points out that the Examiner has improperly construed Lau's ejection port (106) being equal to the outlet opening of Applicant's claimed cap, because Lau's ejection port (106) can not be used for dispensing liquid by tilting the bottle.

Furthermore, Applicant points out that in Lau's dispensing system, straw (110) is fixed on to body (201), and is not movable vertically as required in Applicant's claimed invention.

The deficiencies of Lau are not overcome by Pugh. Pugh's teaching has been discussed above.

Applicant points out that Lau's dispensing system and Pugh's telescopic straw are not combinable. For Pugh's telescopic straw to work, his inner straw 21 has to be able to move up and down inside outer straw 23 which is positioned with the container and near the bottom thereof. As discussed above, Lau's straw (110) is fixed on to the body (210) with a connection perpendicular to longitudinal axis of the bottle. It is apparent to one of ordinary skill in the art that a telescopic straw is structurally incompatible with Lau's dispensing system.

Therefore, one of ordinary skill in the art would not be motivated to combine the references' teaching to obtain Applicant's claimed invention. Even if one would try, in the manner suggested by the Examiner, one would not have the protruding nozzle with an outlet opening enabling dispensing liquid by tilting the bottle.

Since Claims 11 and 12 are dependent upon independent Claim 7, under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 7 is not obvious in view of the prior art of record, as such Claims

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11 and 12 are submitted as being allowable over the art of record.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 7 and 11-12 based upon 35 U.S.C. §103(a).

6. Response to the Rejection of Claim 13 Based Upon 35 U.S.C. §103(a)

Claim 13 is dependent upon independent Claim 7, under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claim 7 is not obvious in view of the prior art of record, as such Claim 13 is submitted as being allowable over the art of record.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 13 based upon 35 U.S.C. §103(a).

It is respectfully submitted that Claims 1-13, the pending claims, are now in condition for allowance and such action is respectfully requested.

Applicant's Agent respectfully requests direct telephone communication from the Examiner with a view toward any further action deemed necessary to place the application in final condition for allowance.

4/5/2006
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